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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|--------------------|
| 10/755,701 | 01/12/2004 | Terry McLean | 10557/2666547 | 3432 |
| 30559 | 7590 | 06/22/2006 | EXAMINER | |
| CHIEF PATENT COUNSEL | | | | SNOW, BRUCE EDWARD |
| SMITH & NEPHEW, INC. | | | | PAPER NUMBER |
| 1450 BROOKS ROAD | | | | 3738 |
| MEMPHIS, TN 38116 | | | | |

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/755,701 | MCLEAN, TERRY | |
| | Examiner | Art Unit | |
| | Bruce E. Snow | 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 May 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 4,13,24,35,51-79,85 and 94-100 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-12,14-23,25-34,36-50,80-84 and 86-93 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/25/04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of containment configuration 1 (figure 3) and the three-component configuration in the reply filed on 4/27/06 is acknowledged. The traversal is on the ground(s) that it is not a burden. This is not found persuasive because applicant arguments are not commensurate with a proper response for an election of species requirement. The election of species requirement stated:

"Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention."

The requirement is still deemed proper and is therefore made FINAL. As stated to applicant in the phone conversation, see at least the brief description of the drawings which describe the various embodiments.

Claims 4,13,24,35,51-79,85 and 94-100 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3738

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-12, 14-23, 25-29, 44-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchholz (4,279,041).

Referring to embodiments, specifically the one shown in figures 1-5, Buchholz teaches:

1. An implant structural member 3 adapted to receive the head of an implant stem, comprising:
 - an outer surface adapted to articulate within an outer shell which is adapted to articulate within an acetabulum and a lip; and
 - an inner surface 18 forming a cavity having a generally spherical shape, the inner surface additionally including a web 13, 14, the web extending around only a portion of the lip of the implant structural member, including an inner surface that is a continuation of the generally spherical shaped inner surface of the implant structural member cavity and shaped to correspond generally to an outer surface of the implant stem head,

the web adapted to allow the implant stem head 1 to be inserted into the structural member cavity when the implant stem head is oriented in a first orientation and constrain the implant stem head within the cavity when the implant stem head is oriented in a second orientation and attached to the stem.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-12, 14-23, 25-34, 36-50, 80-84, 86-93 (all non-withdrawn claims) are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's specification in view of Chambers (3,656,184).

Applicant specification, *Background of the invention*, teaches hip joint prostheses comprising three-components having multiple polarity (articulating surfaces). It teaches materials such as metal, plastic, or ceramic are well known in the art. However, it fails to teach the structural member adapted to receive the head of an implant stem, comprising:

"an inner surface forming a cavity having a generally spherical shape, the inner surface additionally including a web, the web extending around only a portion of the lip of the implant structural member, including an inner surface that is a continuation

of the generally spherical shaped inner surface of the implant structural member cavity and shaped to correspond generally to an outer surface of the implant stem head, the web adapted to allow the implant stem head to be inserted into the structural member cavity when the implant stem head is oriented in a first orientation and constrain the implant stem head within the cavity when the implant stem head is oriented in a second orientation and attached to the stem."

Chambers teaches a hip joint prosthesis which includes a web 6a which extends around only a portion of the lip of the structural member, see figure 2. It would have been obvious to one having ordinary skill in the art to have utilized the ball and structural member configuration taught by Chambers on the known prior art embodiments known in the art such that the "ball member is shaped to pass through the socket opening at one particular orientation for fitting the parts together, but once in place and orientated in normal positions of use the ball member cannot be removed from the socket" to prevent dislocation of the joint.

Claims 1-3, 5-12, 14-23, 25-34, 36-50, 80-84, 86-93 (all non-withdrawn claims) are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's specification in view of Schryver (5,226,917).

Applicant specification, *Background of the invention*, teaches hip joint prostheses comprising three-components having multiple polarity (articulating surfaces). It teaches materials such as metal, plastic, or ceramic are well known in the art. However, it fails to

teach the structural member adapted to receive the head of an implant stem,
comprising:

"an inner surface forming a cavity having a generally spherical shape, the inner surface additionally including a web, the web extending around only a portion of the lip of the implant structural member, including an inner surface that is a continuation of the generally spherical shaped inner surface of the implant structural member cavity and shaped to correspond generally to an outer surface of the implant stem head, the web adapted to allow the implant stem head to be inserted into the structural member cavity when the implant stem head is oriented in a first orientation and constrain the implant stem head within the cavity when the implant stem head is oriented in a second orientation and attached to the stem."

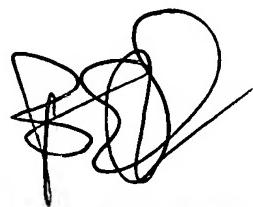
Schryver teaches a hip joint prosthesis which includes a web (the web is the extension of the element 15 beyond its equator best shown in figure 1 which inherently locks the ball) which extends around only a portion of the lip of the structural member forming a generally D-shaped opening. It would have been obvious to one having ordinary skill in the art to have utilized the ball and structural member configuration taught by Schryver on the known prior art embodiments known in the art such that the ball member is shaped to pass through the socket opening at one particular orientation for fitting the parts together, but once in place and orientated in normal positions of use the ball member cannot be removed from the socket to prevent dislocation of the joint.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bes



BRUCE SNOW
PRIMARY EXAMINER